

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

**REMARKS**

This Amendment is being entered in response to the Office Action of August 13, 2003. In this Office Action, the Examiner made the following objections and rejections:

1. The Examiner has rejected claim 1 as allegedly being indefinite.
2. The Examiner has rejected claim 2 as allegedly being indefinite.
3. The Examiner has rejected claim 6 as allegedly being indefinite.
4. The Examiner has rejected claims 7 and 9 as allegedly being indefinite.
5. The Examiner has rejected claims 8-10 as allegedly being indefinite.
6. The Examiner has rejected claim 12 as allegedly being indefinite.
7. The Examiner has rejected claims 1, 11, and 12 as allegedly being unpatentable in view of Lindegren et al. in view of Baumann et al.

Applicants have addressed the Examiner's 103 rejection in light of the revised claim 1. It appears clear to the applicant that the 103 rejection is untenable as the references clearly teach away from their combination. Additional details regarding this rejection may be found elsewhere in this response.

The only outstanding issue appears to be the Examiner's 112 rejections. Applicants have submitted a revised version of claim 1 to better define their invention. Applicants have also submitted new claims 15-29 which are intended to be substantially similar to claims 1-14 except in that the means plus function language has been removed.

Applicants have made a good faith effort to comply with the Examiner's 112 rejection. If the Examiner believes the claim language is still unsatisfactory, applicants would respectfully request the Examiner to call applicants' agent and suggest appropriate language. Applicants' agent would be eager to hear the Examiner's suggestions. Applicants respectfully request reconsideration.

**1. REJECTION OF CLAIM 1**

The Examiner has rejected claim 1 stating:

In claim 1, the claim is incomplete for omitting essential structural cooperative relationship between elements amounting to a gap in the structure. The claim is just a listing of parts with no structural relationship between parts. The means for receiving pulsed radio frequency fields, means for transmitting, the parallel resonant circuit, and means for connecting the device to a heart are not connected directly or indirectly with each other. It can not be determined what the applicant is claiming. In addition, the "means for connecting said cardiac assist device to a heart" and "means for furnishing electrical current from said cardiac assist device to said heart" appear to be the same element, an electrode. Also, "induced by said pulsed radio

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

frequency fields" is inferentially including the pulsed radio frequency fields. The RF fields have not been positively recited and have only been functionally recited ("means for receiving pulsed radio frequency fields") and it is unclear if the applicant is claiming a means for generating a RF fields.

To better describe their invention, applicants have submitted revised language for claim 1. It is respectfully submitted that the revised language obviates the Examiner's rejection. The claim now specifies that the RF fields are received "from a source external to said cardiac assist device." The structural relationships between the various means has now been specified. It is clear from the amended claims that the means for ceasing the flow of electricity is disposed between the cardiac assist device and the means for transmitting and delivering electrical current to and from the heart. Various dependent claims have also been amended to ensure there is proper antecedent basis for the limitations.

It is respectfully submitted that the amendments to claim 1 obviate the Examiner's rejection. A good faith effort has been made to comply with the Examiner's objection to the language of claim 1. If the Examiner believes the claim language is still unsatisfactory, applicants would respectfully request the Examiner to call applicants' agent and suggest appropriate language.

## **2. REJECTION OF CLAIM 2**

The Examiner has rejected claim 2 stating:

In claim 2, "optical means" is vague since there is no function after the means ("optical means for...") and it is unclear if the applicant is trying to use 112 sixth paragraph.

While the applicants do not necessarily agree that the claim is vague, the applicants note that the amendments to claim 1 make the alleged 112 issues of claim 2 a moot point. Applicants have canceled claim 2 as filed. It is respectfully submitted that the Examiner's rejection of the limitation "optical means" has been obviated.

## **3. REJECTION OF CLAIM 6**

The Examiner has rejected claim 3 stating:

In claim 6, "is activated by light from a light source" is inferentially including the light source. The light source has not been positively recited and it is unclear if applicant is positively claiming the light source.

While the applicants do not necessarily agree with the Examiner's assertion that the claim is indefinite, to facilitate prosecution of this application, the applicants have amended the claim to positively recite the element of an activation source. It is respectfully submitted the Examiner's rejection has been obviated.

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

#### **4. REJECTION OF CLAIMS 7 AND 9**

---

The Examiner has rejected claims 7 and 9 stating:

In claims 7 and 9, "is disposed within a biological organism" is vague since it sounds as if the applicant is positively claiming a connection to the body. System claims can not claim connection to the body. It is suggested to use "is adapted to be disposed..."

While the applicants do not necessarily agree with the Examiner's assertion that the claims are indefinite, to facilitate prosecution of this application, the applicants have amended the claims in accordance with the Examiner's suggestion.

#### **5. REJECTION OF CLAIMS 8-10**

---

The Examiner has rejected claims 8-10 stating:

In claims 8-10, the claims are vague and do not limit the parent claim since the light source has not been positively recited.

The applicants note that claims 8-10 are indirectly dependent on claim 6. The applicants note that claim 6 has been amended elsewhere in this response. Claim 6, as amended, positively recites the element of an activation source. Claims 8-10 have been amended to ensure antecedent basis for the term "activation source." The applicants respectfully submit that the amendment to claim 6, and the subsequent formal corrections to claims 8-10, obviates the rejection of claims 8-10.

#### **6. REJECTION OF CLAIM 12**

---

The Examiner has rejected claim 12 stating:

In claim 12, the claim is vague and not limiting the parent claim since the RF fields have not been positively recited. In addition, "a magnetic resonance imager" is inferentially included.

While the applicants do not necessarily agree with the Examiner's assertion that the claim is indefinite, to facilitate prosecution of this application, the applicants have amended the claim to omit the limitation at issue and explicitly recite the MRI.

#### **7. REJECTION OF CLAIMS 1, 11, AND 12 IN VIEW OF LINDEGREN ET AL. IN VIEW OF BAUMANN ET AL.**

---

The Examiner has rejected claims 1, 11, and 12 stating:

Claims 1, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindegren et al (5454837) in view of Baumann et al (5279292).

Lindgren disposes the claimed invention (with the means for protecting the heart from RF fields being the optical conductors in Baumann) except for the

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

means for receiving pulsed RF fields, a parallel resonant frequency circuit, and means for activating said circuit. Baumann teaches that it is known to have means for receiving pulsed RF fields and a parallel resonant frequency circuit (both being the parallel resonant circuit in Baumann) and means for activating said circuit (the external resonant circuit in Baumann) to transfer energy to the implanted device to charge the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implantable device as taught by Lindgren, with the means for receiving pulsed RF fields and a parallel resonant frequency circuit and means for activating said as taught by Baumann, since such modification would provide an IMD with means for receiving pulsed RF fields and a parallel resonant frequency circuit and means for activating said circuit to transfer energy to the implanted device to charge the device.

Applicants respectfully submit that it is improper to combine the references of Lindegren and Baumann. Such a combination is improper, as the proposed modifications would render the device of Lindegren unsatisfactory for its intended purpose. Additionally, such a proposed modification would change the principle of operation of the Lindegren device. Moreover, there is no motivation to combine the two cited references. In fact, the references actually teach away from such a combination.

The Examiner has alleged that Baumann teaches a resonant circuit, means for controlling the resonant circuit, and means for receiving pulsed RF fields. The Examiner has further alleged that Lindegren teaches the claimed device with the exception of a resonant circuit, means for controlling the resonant circuit, and means for receiving pulsed RF fields.

In Lindegren's invention, the transmission of signals along path 10 must be through optical signals. Such optical conductors are incapable of receiving pulsed radio frequency fields. Lindegren teaches away from the use of leads which are capable of receiving pulsed radio frequency fields throughout the specification of United States Patent 5,454,837. See, for example, paragraph 1, lines 30-47; and column 3, line 2; and the like. Modifying the device of Lindegren to make it responsive to such fields would render it unsuitable for its intended purpose as well as change the principle of operation of the device. The M.P.E.P states:

MPEP §2143.01 "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Circ. 1984)

MPEP §2143.01 "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270, F.2d 810, 123 USPQ 349 (CCPA 1959)

Indeed, it was the objective of Lindegren to provide a device that would be minimally responsive to such fields. At column 1, lines 45-47 it is stated "It is an object of the present invention to provide a medical system of the type described above wherein the number of metallic conductors is minimized." Also see column 3, lines 2-6: "This is achieved in accordance with the invention by the use of optical signals, which are unaffected by electromagnetic fields in the environment, thereby making the information transfer more reliable." Clearly, such a modification would all but destroy Lindegren's invention. Similarly, the incorporation of Baumann's resonant circuit into the device of Lindegren would likewise render it unsuitable for its intended purpose.

The Examiner has alleged that Baumann's resonant circuit is a means for receiving pulsed RF fields. "Baumann teaches that it is known to have means for receiving pulsed RF fields and a parallel resonant frequency circuit (both being the parallel resonant circuit in Baumann)." It is clear from the above arguments that Lindegren teaches away from the inclusion of an RF receiver in his invention. The inclusion of such an element would run contrary to the very objective of Lindegren's invention.

MPEP §2145(X)(D)(2) states "It is improper to combine references wherein the references teach away from their combination. *In re Grasselli*, 713, F.2d 731, 743, 218 USPQ 769, 779 (Fed. Circ. 1983).

Since Lindegren clearly teaches away from the inclusion of an RF receiver, it is improper to combine it with a reference so as to force the inclusion of such an element. The fact that the elements can be located in the prior art is insufficient to uphold an obviousness rejection.

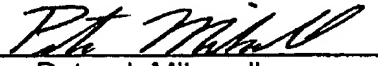
MPEP §2143.01 states "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916, F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Application No. 09/921,066  
Date of Response 02/11/2004  
Reply to Action of 8/13/2003

Clearly there is no suggestion to combine these two references, as evidenced by the Examiner's failure to cite such a motivation in either of the references. In fact, there is ample disclosure in the references which actually does the opposite: teaches away from their combination.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. If, for any reason, the Patent Examiner believes that a telephone conference with applicant's agent might in any way facilitate the prosecution of this case, the Examiner is respectfully requested to call such agent. Additionally, in the event the Examiner finds the amended claim language unacceptable under 35 U.S.C. 112 grounds, the Examiner is respectfully invited to contact applicants' agent to discuss suggested language. Such agent would be grateful for any guidance the Examiner could provide.

Respectfully submitted,  
Howard J. Greenwald P.C.

By   
Peter J. Mikesell  
Reg. No. 54,311  
Telephone (585) 387-0285  
Fax (585) 387-0288